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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/379,872 01/27/95 FLACK

M 1170-480P

EXAMINER

GOLDBERG, J

ART UNIT	PAPER NUMBER
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8

12M1/0124
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1205

DATE MAILED:

01/24/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 10/17/95 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- Notice of References Cited by Examiner, PTO-892.
- Notice of Draftsman's Patent Drawing Review, PTO-948.
- Notice of Art Cited by Applicant, PTO-1449.
- Notice of Informal Patent Application, PTO-152.
- Information on How to Effect Drawing Changes, PTO-1474.
- _____

Part II SUMMARY OF ACTION

- Claims 1, 3, 4 and 9-15 are pending in the application.
Of the above, claims 9-12 are withdrawn from consideration.
- Claims _____ have been cancelled.
- Claims _____ are allowed.
- Claims 1, 3, 4 and 13-15 are rejected.
- Claims _____ are objected to.
- Claims _____ are subject to restriction or election requirement.
- This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- Formal drawings are required in response to this Office action.
- The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).
- The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).
- Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.
- Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 53 O.G. 219.
- Other

EXAMINER'S ACTION

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Claims 9-12 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 6.

Applicants' remarks are noted but the enhanced combination of Group II would support separate patent. Applicants elected the invention of Group I wherein gossypol alone is being employed. Claims 1, 3 and 4 are being examined as they read on the elected invention.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 1, 3, 4 and 13-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Wu et al reference. The Wu et al. reference teaches gossypol for treating carcinomas in

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viva (see Abstract) including mammary carcinomas (page 3754, col. 1, lines 19-24). In view of this, the claim drawn to other carcinomas would be motivated in the application of the prior art anti-carcinoma drug. Moreover, pages 8-10, of specification are drawn to treating SW-13 cells which are the same SW-13 cells employed in the prior art reference.

Claims 1 and 13 rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited in accordance with the disclosure at page 14 of the specification. See M.P.E.P. §§ 706.03(n) and 706.03(z).

The term "cancer" in claims 1 and 13 lacks clear exemplary support in the specification as filed.

Any inquiry concerning this communication should be directed to Examiner Goldberg at telephone number (703) 308-1235. The facsimile center of Group 1200 operates from 8:45 AM to 4:45 PM, Monday through Friday. The numbers for accessing the fax machines are (703)308-4556 and 305-3592.

goldberg: kv
January 5, 1996

JEROME D. GOLDBERG
PRIMARY EXAMINER
GROUP 1200